

REMARKS

Claims 1-5 and 18-29 remain pending in the application. Claims 20-22 stand allowed; the other claims are rejected on obviousness grounds.

Applicants continue to maintain that *prima facie* obviousness has not been established. That issue is ripe for appeal and will be pursued in that forum.

The Final Action notes (para. 2) that the earlier-submitted evidence of commercial success must be supported by an appropriate affidavit or declaration to be of value, citing MPEP § 716.01(c).

The undersigned had earlier intended to offer such a declaration when, in the last response, he stated:

The undersigned represents that these enclosed documents – as well as the web printouts earlier submitted – are true and accurate copies of the documents they purport to be.

The undersigned had understood that such a statement – offered by an attorney admitted to practice by the PTO – would be construed as a suitable declaration (e.g., in view of the PTO's Disciplinary Rules concerning the veracity of statements signed by attorneys admitted to PTO practice).

Out of abundance of caution, a separate Declaration is submitted herewith, with customary language regarding Title 18 of United States Code, etc.

The Examiner is requested to consider the materials earlier submitted in view of such declaration.

Additionally, applicants submit herewith a further item of evidence showing commercial success of the claimed technology: a presentation to the 6th Information Hiding Workshop in May of this year by Steven J. Murdoch of the University of Cambridge, entitled "*Software Detection of Currency*," dated May 23-25, 2004 (labeled Exhibit AA).

Consideration of such evidence is solicited despite the after-final status of the application, because this evidence was not earlier available for submission (Applicants' prior amendment was filed in April, 2004).

On page 3, the Murdoch presentation shows a screen shot presented when image processing software (e.g., Adobe Photoshop, JASC Paintshop Pro), or HP printer drivers, or Canon scanner software, tries to process image data from a banknote. The screen shot shows the message:

!

This application does not support the unauthorized processing of banknote images.

For information, select the information button below for Internet-based information on restrictions for copying and distributing banknote images or go to
www.rulesforuse.org

Page 2 of the Murdoch presentation notes, "*Code seems to have been produced by Digimarc, on behalf of the G10 Central Bank Counterfeit Deterrence Group (27 banks).*"

Digimarc is the assignee of the present application.

Applicants submit that adoption of the assignee's claimed technology by the G10 Central Banks, and its incorporation into products distributed by companies including Adobe, Hewlett-Packard, and Canon, is strong evidence of commercial success.

Since patent term extension is available for this application only during the period of appeal (due to this application's pre-May, 2000 filing date), a Notice of Appeal is submitted herewith.

The undersigned will endeavor to telephone the Examiner in about a month to determine whether the appeal should be pursued, or whether the application appears to be in condition for allowance.

Respectfully submitted,

Date: November 12, 2004

CUSTOMER NUMBER 23735

Phone: 503-469-4800
FAX 503-469-4777

DIGIMARC CORPORATION

By _____
William Y. Conwell
Registration No. 31,943